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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,219	03/30/2004	Tatsuhito Mutoh	O11.2-11521-US01	3864

490 7590 03/18/2005

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER	
MARCHESCHI, MICHAEL A	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/813,219	MUTOH ET AL.	
	Examiner	Art Unit	
	Michael A Marcheschi	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-20* is/are rejected.

7)☒ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/5/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This action is in response to the IDS filed 10/5/04. This IDS was not made part of the record at the time the notice of allowability was mailed (the examiner did not review the above IDS since it was not part of the file when allowed). In view of this, the case is withdrawn form issue and the following rejections can be applied.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4, 6-10, 13-14 and 19-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GB 2,371,555 (cited on the 1449 of 10/5/04).

The reference teaches on page 6, line 24-page 14, line 25 and page 16, lines 26-27, a polishing composition for polishing a substrate (magnetic disks) comprising a polyoxyethylene polyoxypropylene alkyl ether having a defined molecular weight (present in the claimed

amount), an abrasive (**at least one** selected from alpha alumina, colloidal silica, etc.), an acid salt (aluminum nitrate, etc.) and water.

The claimed invention is anticipated by the reference because the reference teaches a composition which comprises all of the claimed components. The recitation of a polyoxyethylene polyoxypropylene alkyl ether having a defined molecular weight broadly reads on the claimed reaction product because all of the materials of the reference product are present in the claimed reaction product absent evidence to the contrary. In the alternative, no patentable distinction is seen to exist between the reference and the claimed invention absent evidence to the contrary because it is the examiners position that the alkyl ether of the reference encompasses the claimed reaction product and therefore **"A generic disclosure renders a claimed species prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)".**

Claims 5, 11, 12, 16-17 are rejected under 35 U.S.C. 103(a) as obvious over GB 2,371,555 (cited on the 1449 of 10/5/04) in view Shemo et al.

Shemo et al. teach in column 7, lines 15-18 that glycols and celluloses are known conventional additives for polishing compositions.

Although the reference does not literally teach the kinematic viscosity of instant claim 5, this is obvious because the claimed reaction product appears to be the same as the alkyl ether of the reference and the same material, which also has the same molecular weigh, is expected (i.e. obvious) to have the same viscosity absent evidence to the contrary.

With respect to the use of a glycol component and a cellulose component, as defined in instant claims 11, 12, 16 and 17, the GB reference states that various known additives can be added for the purposes defined therein and this provides motivation to add the additives (glycol and cellulose) defined by the secondary reference because all these additives are conventionally known additives for polishing compositions. The disclosure that "various known additives can be added" makes the addition of any conventional additive obvious absent evidence to the contrary.

Claim 15 is rejected under 35 U.S.C. 103(a) as obvious over GB 2,371,555 (cited on the 1449 of 10/5/04) in view Ide et al.

Ide et al. teach in column 8, lines 38-40 that antifoaming agents are known conventional additives for polishing compositions.

With respect to the use of an antifoaming agent, the GB reference states that various known additives can be added for the purposes defined therein and this provides motivation to add the additive (antifoaming agent) defined by the secondary reference because this additive is a conventionally known additive for polishing compositions. The disclosure that "various known additives can be added" makes the addition of any conventional additive obvious absent evidence to the contrary.

Claim 18 is rejected under 35 U.S.C. 103(a) as obvious over GB 2,371,555 (cited on the 1449 of 10/5/04) in view Shemo et al. and/or Miyata.

Shemo et al. teach in the abstract that the pH of polishing composition for magnetic disks is known to be between 2 and 5.

Miyata teach in the abstract that the pH of polishing composition for magnetic disks is known to be between about 1 to about 5.

The pH of a polishing composition is dependent on the type of substrate to be polished. Although the GB reference fails to teach the pH, it is the examiners position that the claimed pH values are obvious because these pH values are known for polishing composition for magnetic disk substrates and the pH is dependent on the substrate.

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record **fails** to teach or suggest the claimed reaction product wherein the compound is glycerin.

In view of the teachings as set forth above, it is the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

"A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. ***In re Opprecht*** **12 USPQ 2d 1235, 1236 (CAFC 1989);** ***In re Bode*** **USPQ 12;** ***In re Lamberti*** **192 USPQ 278;** ***In re Bozek*** **163 USPQ 545, 549 (CCPA 1969);** ***In re Van Mater*** **144 USPQ 421;** ***In re Jacoby*** **135 USPQ 317;** ***In re LeGrice*** **133 USPQ 365;** ***In re Preda*** **159 USPQ 342 (CCPA 1968)". In addition, "A**

reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

"A generic disclosure renders a claimed species prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)".

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see ***In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976)".**

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356.

The additional reference cited on the 1449 of 10/5/04 has been reviewed by the examiner and are considered to be art of interest since they are cumulative to or less than the art relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/3/05
MM

Michael A Marcheschi
Primary Examiner
Art Unit 1755